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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Takeshi MIYAKAWA, et al.

SERIAL NO: 10/030,103

GROUP: 1772

FILED: January 17, 2002

EXAMINER: SANDRA M. NOLAN

FOR: ELECTRONIC COMPONENT PACKAGING CONTAINER

LETTER

Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is a The People's Republic of China Office Action for the Examiner's consideration. The references cited therein have been previously filed on January 17, 2002.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
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THE PATENT OFFICE OF THE STATE INTELLECTUAL PROPERTY OFFICE
OF THE PEOPLE'S REPUBLIC OF CHINA

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Shanghai Patent & Trademark Law Office

Date of Dispatch
March 5, 2004

Application No.: 00816391.X	Applicant: DENKI KAGAKU KOGYO KABUSHIKI KAISHA
Application Date: November 27, 2000	Agent:
Title: 电子部品包装容器	

THE FIRST OFFICE ACTION
(PCT APPLICATION IN THE NATIONAL PHASE)

1. According to the Request for Substantive Examination raised by the applicant and based on the provision of Item 1, Article 35 of the Patent Law, the Examiner has proceeded with the Examination as to Substance on the above mentioned application for patent for invention.
 According to Item 2, Article 35 of the Chinese Patent Law, the Patent Office has decided to examine the above application for patent for invention.

2. The applicant has requested that the filling date of 1999.11.29 at the JP Patent Office as the priority date,
_____ at the _____ Patent Office as the priority date,
_____ at the _____ Patent Office as the priority date,

3. The following amended documents submitted by the applicant cannot be accepted for not conforming to the provision of Article 33 of the Patent Law:
 The Chinese version of the attachment of the International Preliminary Examination Report.
 The Chinese version of the amended document submitted according to the provision of Rule 19 of the Patent Cooperation Treaty.
 The amended document submitted according to the provision of Rule 28 or Rule 41 of the Patent Cooperation Treaty.
 The amended document submitted according to the provision of Rule 51 of the Implementing Regulations of the Patent Law.
Refer to the text of the notice for the specific reason of non-acceptance thereof.

4. The examination is conducted by directing at the Chinese version of the original International Application submitted.
 The examination is conducted by directing at the following application documents:
 Description,
p. _____, the Chinese version of the original International Application Document submitted;
p. _____, the Chinese version of the attachment of the International Preliminary Examination Report;
p. _____, the amended document submitted according to the provision of Rule 28 or Rule 41 of the Patent Cooperation Treaty.

- p. _____, the amended document submitted according to the provision of Rule 51 of the Implementing Regulations of the Patent Law.

Claims,

_____, the Chinese version of the original International Application Document submitted.

_____, the Chinese version of the amended document submitted according to the provision of Rule 19 of the Patent Cooperation Treaty.

_____, the Chinese version of the attachment of the International Preliminary Report.

_____, the amended document submitted according to the provision of Rule 28 or Rule 41 of the Patent Cooperation Treaty.

_____, the amended document submitted according to the provision of Rule 51 of the Implementing Regulations of the Patent Law.

Attached Drawings,

p. _____, the Chinese version of the original International Application Document submitted.

p. _____, the Chinese version of the attachment of the International Preliminary Examination Report.

p. _____, the amended document submitted according to the provision of Rule 28 or Rule 41 of the Patent Cooperation Treaty.

p. _____, the amended document submitted according to the provision of Rule 51 of the Implementing Regulations of the Patent Law.

5. This Notice cites the following Comparison Document(the number of which shall continue to be used in the subsequent examination proceedings):

FILED
1-17-02

No.	Number/Title of Document	Date of Publication (or the filing date of the conflicting Application)
1	JP 11-77938A	1999.03.23
2	JP 11147569A	1999.06.02
3		
4		

6. The conclusive opinion drawn from the examination:

As regards the Specification:

- The contents of the application fall under the scope stipulated by Article 5 of the Patent Law for which no patent right should be granted.
- The specification does not conform with the provision of Item 3, Article 26 of the Patent Law.
- The drafting of the specification does not conform with the provision of Rule 18 of the Implementing Regulations.

As regards the Claims:

- Claim _____ does not possess the novelty as stipulated in Item 2, Article 22 of the Patent Law.
- Claim 1-9 does not possess the inventiveness as stipulated in Item 3, Article 22 of the Patent Law.
- Claim _____ does not possess the practical applicability as stipulated in Item 4, Article 22 of the Patent Law.
- Claim _____ falls under the scope of Article 25 of the Patent Law where no patent right is to be granted.
- Claim _____ does not conform with the provision of Item 4, Article 26 of the Patent Law.

- Claim _____ does not conform with the provision of Item 1, Article 31 of the Patent Law.
- Claim _____ does not conform with the provision of Item 1, Rule 13 of the Implementing Regulations of the Patent Law.
- Claim _____ does not conform with the provision of Rule 18 of the Implementing Regulations of the Patent Law.
- Claim _____ does not conform with the provisions of Rules 20 to 23 of the Implementing Regulations of the Patent Law.

Refer to the text of this Notice for the specific analyses of the conclusive opinion.

7. Based on the above conclusive opinion, the Examiner deems that:

- The applicant shall amend the application documents in accordance with the requirements raised in the text of the Notice.
- The applicant shall discuss in his observations reasons why this application for patent can be granted a patent right, and amend the portions indicated in the text of the Notice which have been deemed as not conforming with the provisions, or no patent right shall be granted.
- There are no substantive contents in the application for patent that can be granted a patent right. If the applicant does not present reasons or the reasons presented are not sufficient, the application shall be rejected.

8. The applicant is asked to note the following items:

- (1) According to the provision of Article 37 of the Patent Law, the applicant shall submit his observations within four months from the receipt of this Notice. Where, without justified reasons, the applicant does not respond at the expiration of said date, the application shall be deemed to have been withdrawn.
- (2) The applicant shall amend his application according to Article 33 of the Patent Law. The amended documents shall be in duplicate, and the form, in conformity with the relevant provisions in the Examination Guide.
- (3) The applicant and/or his agent can not, without first making an appointment, go to the Patent Office to have an interview with the Examiner.
- (4) The observations and/or the amended documents shall be mailed or delivered to the Department of Receipt, the Patent Office of the State Intellectual Property Office. No documents shall possess legal effects if not mailed or delivered to the Department of Receipt.

9. The text of this Notice totals 2 page(s), and includes the following attachment(s):

- duplicate copy(ies) of cited comparison document(s), altogether 2 copy(ies) 11 pages.
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Examination Department: _____ Examiner(Seal):

THE TEXT ON FIRST OFFICE ACTION

As described in the specification, the present application relates to an electronic component packaging container. After Examination, the examiner's concrete remarks are as follows:

Claim 1 does not have inventiveness, not conforming with the provision of Item 3, Article 22 of the Chinese Patent Law. Claim 1 substantively claims the application of a multi-layer polyester, which, however, has been disclosed by reference JP11-77938A (referred to as Reference 1). Reference 1 has disclosed that a formed article is formed by a heat-resistant and transparent multi-layer polyester sheet, which comprises a substrate containing polyethylene terephthalate resin and polycarbonate resin and having a surface layer disposed thereon, wherein the content of polyethylene terephthalate resin is 70~97pts. wt, that of polycarbonate resin is 3~30pts. wt, both in terms of the total weight of the polyethylene terephthalate resin and polycarbonate resin, and the surface thickness occupies 10~30% of the total thickness (See line 32 of column 2 to line 14 of column 3 and the examples of the description of Reference 1). The application claimed by claim 1 only uses the well-known properties of a known material. Furthermore, the other reference, JP 11147569A (referred to as Reference 2) has disclosed a packaging apparatus, concretely, an antistatic apparatus is a strip-type electronic component packing apparatus, an antistatic apparatus have its surface coated by a macromolecular antistatic agent and the coating has a resistance of $10^7\sim 10^{12}\Omega$ (See the claims, lines 15~41 of column 2, drawings and examples of Reference 2). Accordingly, it is apparent to the skilled person in the art to obtain the technical solution of claim 1 by using the well-known properties of the known material on the basis of Reference 2. Therefore, claim 1 does not have prominent substantive features nor represents notable progress, not having inventiveness.

Claim 2 limits the total light transmittance and cloudiness, which, however, have been limited in Reference 1 (See examples 1~3 and Table 1 of Reference 1). Accordingly, it is apparent to the skilled person in the art to obtain the technical solution of claim 2 on the basis of References 1 and 2. Therefore, claim 2 does not have prominent substantive features nor represents notable progress, not having inventiveness.

Claim 3 depends on claim 1 or 2. However, the additional technical feature of claim 3 has been disclosed by Reference 2 (See the claims, lines 15~41 of column 2, drawings and examples of Reference 2). Accordingly, it is apparent to the skilled person in the art to obtain the technical solution of claim 3 on the basis of References 1 and 2. Therefore, claim 3 also does not have prominent substantive features nor represents notable progress, not having inventiveness.

Claim 4 claims a sheet. However, on the basis of References 1 and 2 (See examples 1~3 and Table 1 of Reference 1; the claims, lines 15~41, drawings and examples of Reference 2), the skilled person in the art can obtain the technical solution of claim 4 without any creative work. Therefore, claim 4 also does not have prominent substantive features nor represents notable progress, not having inventiveness.

Dependent claims 5~8 limit other additional technical features. However, on the basis of References 1 and 2 (See examples 1~3 and Table 1 of Reference 1; the claims, lines 15~41, drawings and examples of Reference 2), the skilled person in the art can obtain the technical solutions of these claims without any creative work. Therefore, these claims also do not have prominent substantive features nor represents notable progress, not having inventiveness.

In light of the above reasons, claims 1~9 of the present application do not have inventiveness. At the same time, there is no other patentable substantive contents disclosed in the description. Even if the applicant recombines and/or further limits the claims according to the contents of the description, the present application still has no foreground of being granted a patent right. If the applicant cannot provide enough reasons to prove that the present application has inventiveness before/on the deadline set by this Notice, the present application will be rejected.

Our Comments and Suggestions

Having carefully studied the Notice on First Office Action, our comments and suggestions are as follows:

1. With respect to the objection to the inventiveness of claim 1, the examiner is of the same opinion as in IPEA that claim 1 does not have inventiveness in contrast with the combination of References 1 and 2 according to Item 3, Article 22 of the Chinese Patent Law: "inventiveness means that, as compared with the technology existing before the date of filing, the invention has prominent substantive features and represents a notable progress".

After carefully comparing the present invention with the cited references, we found that the structure of the sheet of the present invention is nearly the same as that of Reference 1, their difference lies in that: Reference 1 has disclosed a sheet used to pack food without mentioning the ratio or the thickness of the surface layers relative to the total thickness or the electrical properties of said sheet. However, the examiner deemed that the use of said sheet to pack the electronic component can be conceived from the use of packing food disclosed in Reference 1 according to the well-known properties of said sheet.

Furthermore, Reference 2 has disclosed a carrier tape used to pack electronic component comprising an antistatic coating and a substrate made from A-PET, PS, PVC, PC. Although the sheet of Reference 2 does not comprise a PC surface layer and the thickness ratio of the layers are different from that of the present invention, the examiner deemed that the skilled person in the art can conceive to use the similar sheet of the present invention in the same application as in Reference 2 on the basis of the combination of References 1 and 2.

Under these circumstances, we expect the applicant can provide sufficient evidences to prove that the technical solution of claim 1 cannot be easily obtained by the combination of References 1 and 2 and has

some unexpected technical results over the cited reference, so as to convince the examiner that the technical solution of claim 1 has inventiveness.

2. With respect to the objection to claims 2~3, we think if the examiner can be convinced that claim 1 has inventiveness, its dependent claims 2 and 3 will also be accepted.

3. With respect to the objection to independent claim 4, we agree with the examiner's opinion. Claim 4 claims a sheet without telling its use in packing electronic component, which is different from the sheet of Reference 1 in further comprising a conductive coating and limiting its surface resistance. Therefore, claim 4 does not have identical or corresponding special technical features with those in claim 1, not having unity. If the applicant cannot prove that claims 1 and 4 have unity, it is suggested to delete claim 4, and the applicant may add a new dependent claim to limit the conductive coating and surface resistance of the sheet of claim 1.

4. With respect to the objection to claims 5~9, we think they, after being amended correspondingly to the amendments on claim 4, will also be accepted in the case of claim 1 being proved to have inventiveness.

It should be noted that our understanding may not be correct because we may not know the present invention and its background as clearly as the applicant does, so the above comments and suggestions are only for your reference. Please provide us with your detailed instructions on how to respond to the Office Action and how to amend the claims. It would be appreciated very much if you could give us your instructions at your earliest convenience.